

added. Reconsideration of the application and allowance of claims 8-10 and 22-25 are respectfully requested.

Restriction Requirement

The Examiner issued a restriction requirement indicating that claims 1-7 and 11-18 are drawn to a method of attaching a label to a container (Group I) and claims 8-10 and 19-22 are drawn to a safe container with a label (Group II). The Examiner correctly noted that “During a telephone conversation with Applicants’ attorney, Marc Sockol, on February 8, 2001, a provisional election was made with traverse to prosecute the invention of Group II, Claims 8-10 and 19-22.” Accordingly, Applicants hereby affirm the telephonic election of Group II, consisting of claims 8-10 and 19-22. Non-elected claims 1-7 and 11-18 have been canceled.

Claim Rejections Under 35 U.S.C. §103(a)

Claims 8-10 and 19-22 have been rejected under 35 U.S.C. §103(a) as unpatentable over Admitted Prior Art in view of Katsura et al. (U.S. Patent No. 5,223,315). Claims 19-21 have been canceled, rendering the rejection moot as to claims 19-21.

Applicants’ claim 8 recites “a semi-permeable container having a polymeric external surface; and a metallic layer bonded directly to the external surface.” The Examiner stated that “Admitted Prior Art discloses generally all of the elements of the claims, but lacks a metallized polyester layer on the label.” Applicants respectfully submit that page 1 of the specification, which was identified as Admitted Prior Art by the Examiner, does not disclose all of the elements of claim 8. Specifically, Admitted Prior Art does not disclose or suggest “a metallic layer bonded directly to the external surface” of a container. Indeed, Admitted Prior Art fails to mention “a metallic layer” at all.

Regarding Katsura et al., the Examiner stated that “The label in Figure 1-B has a print layer 3 attached to a metallic layer 5. The metallic layer is bonded to the container.” Applicants respectfully direct the Examiner’s attention to Katsura et al.’s Figure 1-B, which depicts a hot-melt adhesive 4 coated on the metallic layer 5. At Column 7, lines

54-56, Katsura et al. teaches that this “hot-melt adhesive is heat-bonded to the plastic material being formed by the blow-forming.” The plastic material being formed by blow-forming in Katsura et al. is a plastic vessel or container. Thus, Katsura et al.’s adhesive 4 lies between metallic layer 5 and the outer surface of the container.

In contrast, Applicants’ specification as originally filed stresses the avoidance of adhesives between the metallic layer and the container throughout. In particular, Applicants’ specification specifically states that “the techniques described...do not use adhesives...thereby protecting the contents from label contaminants” (page 6, lines 19-21, emphasis added). Thus, in light of Applicants’ specification, “a metallic layer bonded directly to the external surface” of the container, as recited by Applicants’ claim 8,<sup>✓</sup> cannot be read to include a metallic layer bonded to a container with an adhesive, as is taught by Katsura et al. Therefore, since Katsura et al. cannot make up for the deficiencies of Admitted Prior Art, the combination of Katsura et al. and Admitted Prior Art does not teach or suggest every element of claim 8.

In addition, Applicants respectfully direct the Examiner’s attention to Admitted Prior Art at page 1, line 23 – page 2, line 2, which states that “...packagers place labels onto the semi-permeable containers typically using adhesives. Unfortunately,... adhesives... migrate through the semi-permeable container and contaminate the product contents.... Therefore, methods and containers for preventing contamination of products packaged in semi-permeable containers from product labels and adhesives are needed.” In contrast, Katsura et al. teaches the use of thermoplastic adhesive 4 to bond a label to a container (Figures 1B and 1C; Column 7, line 57 – Column 8, line 19). Thus, Admitted Prior Art and Katsura et al. teach away from one another with respect to the use of adhesives. Accordingly, Admitted Prior Art and Katsura et al. cannot be combined to render Applicants’ claim 8 obvious.

For at least the above reasons, claim 8 is patentably allowable over Admitted Prior Art in view of Katsura et al. Claims 9 and 10 depend from claim 8. Therefore, claims 9 and 10 are patentably allowable over Admitted Prior Art in view of Katsura et al. for at least the same reasons as claim 8.

Applicants' amended claim 22 recites "obtaining a semi-permeable container having an external surface and having a metallic layer bonded to the external surface; and coupling a printed layer to the metallic layer" (emphasis added). As discussed above with regard to Applicants' claim 8, neither Admitted Prior Art nor Katsura et al. disclose or suggest "a metallic layer bonded to the external surface" of a container. Therefore, the combination of Katsura et al. and Admitted Prior Art does not teach or suggest every element of claim 22. Further, as also discussed above, Admitted Prior Art and Katsura et al. teach away from one another with respect to the use of adhesives, and thus the references cannot be combined to render Applicants' claim 22 obvious. Accordingly, for at least the above reasons, claim 22 is patentably allowable over Admitted Prior Art in view of Katsura et al.

Claims 19-22 have been rejected under 35 U.S.C. §103(a) as unpatentable over Admitted Prior Art in view of Dornbusch et al. (U.S. Patent No. 4,883,697). Claims 19-21 have been canceled, rendering the rejection moot as to claims 19-21.

The Examiner stated that "Admitted Prior Art discloses generally all of the elements of the claims, but lacks a metallized polyester layer and a polymeric layer on the label." Applicants respectfully submit that Admitted Prior Art does not disclose all of the elements of claim 22. Specifically, Admitted Prior Art does not disclose or suggest "a ... container having ... a metallic layer bonded to the external surface" of the container, as recited by claim 22.

Regarding Dornbusch et al., the Examiner stated that "The label in Figure 2 shows a laminated label comprising printed layer 140, metallized layer disposed on the polyester material 114, 117, and a plastic layer 130. The plastic layer is bonded to the container." Applicants respectfully point out that Dornbusch et al.'s Figure 2 teaches adhesive 120 between the container and the metallized layer. In contrast, Applicants' invention "advantageously places a protective metallic layer onto a semi-permeable container to prevent label...adhesives from migrating into the container. Thus, the protective layer helps to prevent contamination of the product contents" (Specification, page 2, lines 23-26). Applicants therefore respectfully submit that "a ... container

having ... a metallic layer bonded to the external surface," as recited in Applicants' claim 22 and defined in Applicants' specification as excluding the use of adhesives therebetween, is impossible in Dornbusch et al., as the reference teaches the use of adhesive 120 between the container and the metallized layer. Thus, since Dornbusch et al. cannot make up for the deficiencies of Admitted Prior Art, the combination of Dornbusch et al. and Admitted Prior Art does not teach or suggest every element of claim 22.

Further, as discussed above, Admitted Prior Art cautions against the use of adhesives. In contrast, as also discussed above, Dornbusch et al. teaches the use of adhesive 120 between the container and the metallized layer. Thus, Admitted Prior Art and Dornbusch et al. teach away from one another with respect to the use of adhesives. Accordingly, Admitted Prior Art and Dornbusch et al. cannot be combined to render Applicants' claim 22 obvious.

In addition, Applicants respectfully submit that Dornbusch et al. relates to nonanalogous art because the reference is not reasonably pertinent to the problem facing Applicants. The Federal Court elaborated on when a reference is "reasonably pertinent" to the problem faced by the inventor in In re Clay, 23 USPQ 2d 1058, 1061 (Fed. Cir. 1992):

A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem. Thus, the purposes of both the invention and the prior art are important in determining whether the reference is reasonably pertinent to the problem the inventor attempts to solve. If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem, and that fact supports the use of that reference in an obviousness rejection.... If it is directed to a different purpose, the inventor would have accordingly had less motivation or occasion to consider it. (Emphasis added.)

The invention in Dornbusch et al. is directed to providing "a flexible multilayer label for application to deformable, thermoplastic packages" that is "impervious to water

and sufficiently resilient to avoid permanent deformation (e.g., wrinkling, cracking, delamination, etc.) upon deflection" (Column 2, lines 60-66). In contrast, Applicants' invention is directed to placing "a protective layer onto a semi-permeable container to prevent label inks and adhesives from migrating into the container" and thereby "prevent contamination of the product contents" (Specification, page 2, lines 23-26). Indeed, Dornbusch et al. focus on the problem of preventing deformation of the label on a container, while Applicants focus on the problem of preventing contamination of the contents of a labeled container. As Dornbusch et al. is directed to a different purpose than Applicants' invention and therefore is not "reasonably pertinent" to the Applicants' invention, Dornbusch et al. is an improper reference against the present application. Accordingly, for at least the above reasons, claim 22 is patentably allowable over Admitted Prior Art in view of Dornbusch et al.

New Claims 23-25

New claims 23-25 have been added. Support for claims 23-25 is found in the specification at page 4, lines 18-26.

CONCLUSION

For the above reasons, Applicants respectfully submit that claims 8-10 and 22-25 are in condition for allowance, and allowance thereof is requested.

Attached hereto is a marked-up version of the changes made by the current amendment, which is captioned "**Version With Markings To Show Changes Made.**"



PATENT  
Docket no. 42445.00059

Should the Examiner wish to discuss any aspect of this case, he is encouraged to telephone Applicants' attorney at (650) 856-6500.

Respectfully submitted,

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CERTIFICATE OF MAILING

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to the Commissioner for Patents, Washington, D.C. 20231, on Date: 5-10-01 By:



## Version With Markings To Show Changes Made

### **In the Title:**

The title on page 1, lines 1-2 has been amended as follows:

Method[s] And Containers For Preventing Contamination Of Products From  
Product Labels And Adhesives

### **In the Specification:**

The paragraph beginning on page 2, line 10 has been amended as follows:

In one embodiment, the method comprises obtaining a semi-permeable container having a polymeric external surface, obtaining a metallic layer, placing the metallic layer against the external surface, and melting at least a portion of the external surface beneath the metallic layer. The metallic layer may include metallized polyester such as Mylar® metallized polyester manufactured by E.I. duPont de Nemours and Company.

The paragraph beginning on page 2, line 23 has been amended as follows:

The method of the present invention advantageously places a protective metallic layer onto a semi-permeable container to prevent label inks and adhesives from migrating into the container. Thus, the protective layer helps to prevent contamination of the product contents.

### **In the Abstract of the Disclosure:**

The title of the Abstract of the Disclosure on page 1, lines 1-2 has been amended as follows:

Method[s] And Containers For Preventing Contamination Of Products From  
Product Labels And Adhesives

**In the claims:**

Claims 1-7 and 11-21 have been canceled.

New Claims 23-25 have been added as follows:

23. The safe container of claim 8, wherein the semi-permeable container includes a pharmaceutical bottle.

24. The safe container of claim 8, wherein the semi-permeable container includes an IV bag.

25. The safe container of claim 8, wherein the semi-permeable container includes a plastic-wrapped food package.